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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/790,351	03/01/2004	Craig J. Berry	806P011259-US (PAR)	9377				
2512 PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824	7590 05/29/2007		<table border="1"><thead><tr><th colspan="2">EXAMINER</th></tr></thead><tbody><tr><td colspan="2">RAMACHANDRAN, UMAMAHESWARI</td></tr></tbody></table>		EXAMINER		RAMACHANDRAN, UMAMAHESWARI	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/790,351	<b>Applicant(s)</b> BERRY ET AL.	
	<b>Examiner</b> Umamaheswari Ramachandran	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Response to Election/Restrictions**

Applicants' election of group II, claims 8-18 in the reply filed on Apr 9 2007 is acknowledged. Claims 1-7 are withdrawn from consideration. The election has been made with traverse. The Applicants' argue that the product claims have been grouped with process claims. Claims 19 and 20 were grouped with the method claims as they are dependent on claim 1. Claims 19 and 20 are now grouped with group II claims and will be examined. The restriction requirement elected is made final. Claims 8-20 are pending.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 8-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Berry et al. (U.S. 2005/0019588, effective filing date Aug 23 2002).

Berry et al. teach a thin film strip composition comprising water, liquid soluble polymer such as pullulan, low temperature melt polymer such as polyethylene glycol and mixtures thereof (p 1, para 0020, p 8, claims 18-30) and a cosmetic or skin care product incorporated within the polymer matrix (para 0019). The reference teaches that the film is useful for dermatological or cosmetic substances such as skin emollients, fragrances etc and may be used to deliver the active ingredient or cosmetic (p 3, para

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0048, 0056). The reference further teaches that the polymers in the lightweight cosmetic or skin product are in the form of a laminated film where each layer of the laminate contains a cosmetic or a skin care active component and the layers can be laminated on top of each other or laminated side by side (p 8, claims 23-25). The reference also teaches the thickness of the film to be in the range of 0.25 to 12 mils.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 8-12, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Horstmann et al. (U.S. 6,800,329).

Horstmann et al. teach a sheet-like administration form for applications as cosmetic, pharmaceutical or food products (col. 1, lines 7-9). The reference teaches hydrophilic basic polymer such as pullulan, starch etc and with added cosmetic agents (col. 2, line 36, col. 5, claim 10). The reference further teaches that hydrophile additives such as polyethylene glycol may be added (col. 2, lines 42-49). The reference teaches the process of making the sheet-like structures where the solid components are digested in solvents such as water, ethanol etc. (col.3, lines 20-25).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann et al. (U.S. 6,800,329) in view of Berry et al. (U.S. 2005/0019588, effective filing date Aug 23 2002).

Horstmann et al. teachings discussed as above.

Horstmann teach the lamination of two polymers with each other (col. 4, lines 54-56).

The reference do not teach that each layer of the laminated film contains a cosmetic or active skin care ingredient or laminated layers on top of each other or laminated side by side and the thickness of the film.

Berry et al.'s teachings discussed as above. The reference teach the problems associated with high loadings of active ingredients can be solved by laminating multiple layers of thin films to one another, where the films have physical and/or chemical properties which are modified depending on the function that layer plays in the laminate structure. Thus, higher loading may be provided in inner layers with the outer layers having lower loadings or even no actives present.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have the layers of laminated film with a cosmetic or active skin care

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ingredient or laminated layers on top of each other or laminated side by side. The motivation to do so is provided by Berry et al. The reference teach the lamination of the sheet layers dispersed with cosmetic ingredients and also teach the laminated layers on top of each other and laminated side by side. The reference teach the problems associated with high loadings of active ingredients can be solved by laminating multiple layers of thin films to one another, where the films have physical and/or chemical properties which are modified depending on the function that layer plays in the laminate structure. Thus, higher loading may be provided in inner layers with the outer layers having lower loadings or even no actives present. Hence one of ordinary skill in the art would have been motivated to laminate the sheet layers loaded with cosmetic ingredients to overcome the high loadings of active ingredients as taught by Berry et al. It would have been obvious to one of ordinary skill in the art at the time of the invention to make a film with a thickness in the range of 0.25 to 12 mils because Berry et al. have successfully shown in his teachings a film with the thickness in that range comprising pullulan and other solid low melt temperature polymer with active cosmetic and skin ingredients dispersed in the matrix. Hence one would have been motivated to make a film with the thickness in the range mentioned above to achieve similar success in making the films with the cosmetic and skin ingredients dispersed in the matrix.

### **Conclusion**

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umamaheswari Ramachandran whose telephone

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number is 571-272-9926. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER